

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Docket No. 1811)

IFW
AF



In re Application of:

Von K. McConnell et al.

Serial No.: 10/071,833

Filed: February 7, 2002

For: Method and System for Facilitating
Services in a Communication Network
Through Data-Publication By a
Signaling Server

Group Art Unit: 2143

Examiner: Kyung H. Shin

Confirmation No. 2846

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

TRANSMITTAL LETTER

Sir:

In regard to the above identified application:

1. We are transmitting herewith the attached:
 - A. Reply Brief; and
 - B. Return Receipt Postcard.
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3. Please charge any additional fees or credit overpayment to Deposit Account No. 210765. A duplicate copy of this sheet is enclosed.
4. CERTIFICATE OF MAILING UNDER 37 CFR § 1.8: The undersigned also hereby certifies that this Transmittal Letter and the paper, as described in paragraph 1 hereinabove, are being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on this 5th day of September, 2006.

By:

Lawrence H. Aaronson
Reg. No. 35,818



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Lawrence H. Aaronson
McDONNELL BOEHNEN
HULBERT & BERGHOFF LLP
300 South Wacker Drive
Chicago, Illinois 60606
(312) 913-0001

A. Introduction

The Examiner's Answer mailed July 17, 2006 failed to rebut the points of clear error identified in Applicant's Appeal Brief. This Reply Brief addresses the specific arguments made in the Examiner's Answer.

Applicant also notes that both the Examiner and Applicant have incorrectly referred to the Maggenti patent as U.S. Patent No. 6,447,150. The Maggenti patent is U.S. Patent No. 6,477,150.

B. Argument

1. Reply to Examiner's Points A.1 and A.2 (Claims 1 and 2)

As explained in Section VII(1)(a) of Applicant's Appeal Brief, Maggenti does not teach a network entity that carries out the set of functions recited by claim 1. At a minimum, for instance, Maggenti does not teach a network entity (i) receiving a signaling message, (ii) extracting data that can be used by an application server to carry out a communication service in response to the signaling message, (iii) outputting *the signaling message* for transmission to the application server, and (iv) making the extracted data available for use by the application server.

In the Examiner's Answer, the Examiner argued that Maggenti does teach this set of functions. In particular, the Examiner cited various portions of Maggenti. But those cited portions merely teach: (i) the existence of a communications manager (CM) entity, (ii) the concept of SIP communications, (iii) the fact that the CM stores user profile information, (iv) a destination SIP user-agent including session description/signaling parameters in its response SIP message, (v) the fact that the CM receives and processes SIP communications, and (vi) the fact that a communication device (CD) may store group data.

The portions of Maggenti cited by the Examiner do not disclose or suggest the invention of claim 1, and the Examiner's citation of those portions does not overcome the clear deficiency of Maggenti as pointed out in Section VII(1)(a) of the Appeal Brief. For the reasons set forth in

that section of the Appeal Brief, Applicant submits that Maggenti does not anticipate claims 1 and 2.

2. Reply to Examiner's Points A.3, A.4, and A.5 (Claims 3-10, 17-19, and 21-25)

As explained in Section VII(1)(b) of the Appeal Brief, Maggenti does not teach receiving an initiation message indicative of a request by an entity to engage in a communication, responsively extracting data usable by an endpoint application to set up the session, and outputting *the session initiation message* for transmission to the endpoint application and making the set of data available for use by the endpoint application. Further, as explained in Section VII(1)(c) of the Appeal Brief, Maggenti does not teach a system that extracts data from a user-profile store in response to a session initiation message and makes that data available for use by an endpoint application to which the system sends the session initiation message that it receives.

In the Examiner's Answer, the Examiner disputed Applicant's argument by stating that Maggenti teaches the CM maintaining user profile information and the CD maintaining group-list data for users, and arguing that "it would have been obvious to anyone skilled in the art to access, extract, and manipulate the user specific information within the CM and CD database(s) to setup and manage a communications session between two network endpoints." (See page 24 of the Examiner's Answer). However, the Examiner has not rejected claims 3-10, 17-19, and 21-25 on grounds of *obviousness* under 35 U.S.C. § 103. Rather, the Examiner has rejected claims 3-10, 17-19, and 21-25 on grounds of alleged *anticipation* under 35 U.S.C. § 102. Therefore, the Examiner's argument regarding whether the invention of these claims would have "been obvious to anyone skilled in the art" is inapposite. Furthermore, the Examiner has not cited any objective evidence that supports the Examiner's new position that the invention of these claims would have obvious. Regarding *anticipation*, Maggenti does not disclose the invention of these claims, for the reasons set forth in Sections VII(1)(b) and (c) of the Appeal Brief.

The Examiner noted that Applicant admitted Maggenti teaches (i) a user profile database, (ii) a CM generating and sending a response SIP message to a CD, and (iii) a CM application extracting data from a database to facilitate carrying out a communication service. (See pages 24-25 of the Examiner's Answer.) The Examiner then argued that the CD is the endpoint application and that data must be extracted from a database and transferred to the endpoint CD. Even these assertions by the Examiner were supported by Maggenti, the points do not overcome the deficiency of Maggenti. Maggenti does not disclose the invention of these claims for the reasons set forth specifically in Sections VII(1)(b) and (c) of the Appeal Brief.

Furthermore, the Examiner cited various portions of Maggenti in an effort to establish that Maggenti teaches receiving a request to initiate a communication, responsively extracting from a data store a set of data usable by an endpoint application to set up the communication, and outputting the initiation message for transmission to the endpoint application and "thereby" making the set of data available for use by the endpoint application to set up the communication. (See "As to point A.4" section at page 25 of the Examiner's Answer.)

However, the portions of Maggenti cited by the Examiner in this regard do not stand for invention recited in Applicant's claims. Rather, the cited portions merely teach (i) the fact that the CM receives and processes SIP messages, (ii) a destination SIP user-agent including session description/signaling parameters in its response SIP message, (iii) the fact that the CM stores a net database and a user database, and (iv) the fact the CM can send and receive data packets. The Examiner's citation of these portions is insufficient to establish anticipation of Applicant's claims, particularly given that Maggenti fails to teach the claimed invention.

Because Maggenti does not teach all of the elements of any of claims 3-10, 17-19, and 21-25 as explained in Sections VII(1)(b) and (c) of the Appeal Brief, Applicant submits that Maggenti does not anticipate claims 3-10, 17-19, and 21-25.

3. Reply to Examiner's Points A.6 and A.7 (Claims 26-29 and 31-35)

As explained in Section VII(1)(d) of the Appeal Brief, Maggenti does not teach any platform that (i) receives a session initiation message and forwards the session initiation message along to an application server and (ii) extracts from a profile store data usable by the application server to facilitate performance of a service in response to the session initiation message and makes the data available for use by the application server to facilitate performance of the service.

In the Examiner's Answer, where the Examiner addressed this point (Examiner's Points A.6 and A.7), the Examiner did not dispute Maggenti's failure to teach the claimed platform that extracts from a profile store data usable by the application server to facilitate performance of a service in response to the session initiation message and makes the data available for use by the application server to facilitate performance of the service. Rather, the Examiner has merely argued that it is known to receive and forward SIP messages and that it is known to provide a software and firmware based CM.

Because Maggenti does not teach all of the elements of any of claims 26-29 and 31-35, as explained in Section VII(1)(d) of the Appeal Brief, Applicant submits that Maggenti does not anticipate claims 26-29 and 31-35.

4. Reply to Examiner's Point A.8 (Claims 36-40)

As explained in Section VII(1)(e) of the Appeal Brief, Maggenti does not teach a method that involves (i) receiving into a registration server a signaling message indicating that a user is online in a communication network, and (ii) the registration server responsively extracting from a data store a buddy-list designated for the user, and the registration server making the buddy-list available for use by an application server in setting up a communication for the user.

In the Examiner's Answer, in response to Applicant's argument on this point, the Examiner merely cited various portions of Maggenti to establish that Maggenti teaches (i) the existence of an administration interface for administering a CM, and (ii) the existence and use of

buddy lists for use by an application setting up a group communication session. (See page 27 of the Examiner's Answer.) Further, in an effort to make these portions of Maggenti's disclosure appear more relevant to Applicant's invention, the Examiner suggested that the concept of CM "administration" in Maggenti should be interpreted to mean "registration. (*Id.*) Yet the Examiner provided no objective basis for this interpretation.

The portions of Maggenti cited by the Examiner in this regard do not teach the invention recited in Applicant's claims. Rather, at best (as explained in Section VII(1)(e) of the Appeal Brief), Maggenti teaches a CM receiving and processing a SIP INVITE, and an initiating CD having or obtaining a list of nets. However, as explained in Applicant's Appeal Brief, the Examiner cannot interpret *the CM* to be the "registration server" for part of claim 36 (i.e., for purposes of receiving a message) and *the CD* to be the registration server for another part of claim 36 (i.e., for purposes of extracting data and making the data available for use by an application server). Maggenti does not teach the combination of (i) receiving into a registration server a signaling message indicating that a user is online in a communication network, and (ii) the registration server responsively extracting from a data store a buddy-list designated for the user, and the registration server making the buddy-list available for use by an application server in setting up a communication for the user.

Further, in an effort to rebut Applicant's position, the Examiner asserted in the Examiner's Answer that Applicant admitted the CM may obtain the buddy list and that group communications are based on SIP signaling. (See page 27 of the Examiner's Answer (citing Applicant's Appeal Brief at page 10, lines 12-15)). However, this reading of Applicant's Appeal Brief is erroneous. The Appeal Brief does not state that that the *CM* may maintain the buddy list. Rather, it states, "the *CD* may contain or maintain a buddy-list" (Emphasis added.) Therefore, the Examiner's assertion is moot.

Still further, the Examiner again noted Applicant's admission that the CM extracts some data while setting up a communication session. (See page 27 of the Examiner's Answer (citing Applicant's Appeal Brief at page 8, lines 19-20)). And the Examiner asserted that a CM would have to reference user profile data when setting up a communication session. Accepting those two points, however, Maggenti still does not teach the invention recited in Applicant's claims. At a minimum, Maggenti does not disclose the combination of (i) receiving into a registration server a signaling message indicating that a user is online in a communication network, and (ii) the registration server responsively extracting from a data store a buddy-list designated for the user, and the registration server making the buddy-list available for use by an application server in setting up a communication for the user.

Because Maggenti does not teach all of the elements of any of claims 36-40, as explained in Section VII(1)(e) of the Appeal Brief, Applicant submits that Maggenti does not anticipate claims 36-40.

5. Reply to Examiner's Point B.1 (Claims 12-16)

As explained in Section VII(2)(a) of the Appeal Brief, Maggenti does not disclose or suggest that when a proxy server receives an initiation message, the proxy server would (i) extract from a data store a set of data usable by an application server to set up the communication and (ii) forward the initiation message to the application server and make the set of data available for use by the application server in responding to the initiation message.

The Examiner has relied principally on Maggenti for an alleged disclosure of this claimed proxy server functionality. The Examiner relied on the secondary Holden reference merely for Holden's teaching of a proxy server used to proxy session initiation messages, and for Holden's teaching of instant message communication.

In the Examiner's Answer, the Examiner cited to portions of Maggenti that describe (i) a CM proxying data packets from one CD to another, (ii) CDs using SIP to find, join, and leave

nets, (iii) packet data communication between a CM and CDs, and (iv) the CM the fact receiving and processing SIP communications. Yet these portions do not suggest the invention particularly recited in Applicant's claims.

Because the combination of Maggenti and Holden does not disclose or suggest all of the limitations in any of claims 12-16, a *prima facie* case of obviousness of claims 12-16 does not exist.

C. Conclusion

Applicant has demonstrated that the rejections of claims 1-41 are in error as a matter of law. Applicant therefore requests reversal of the rejections and allowance of all pending claims in this application.

Respectfully submitted,

**MCDONNELL BOEHNEN
HULBERT & BERGHOFF LLP**

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By: 

Lawrence H. Aaronson
Reg. No. 35,818